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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,518

11/25/2003

Koji Yamaya

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

08/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/721,518

Applicant(s)

YAMAYA ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice of Amendment

In response to the amendment filed on August 2, 2007, amended claims 5, 7 and 9; canceled claims 1-4 and 8; and new claim 10 are acknowledged. The finality of the previous office action mailed March 26, 2007 is withdrawn. The following new grounds of rejection are set forth.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 recites the limitation "the edge surface". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,352,503 to Matsui et al. in view of U.S. Patent Application Publication No. 2003/0163029 to Sonnenschein et al.

In regards to claims 7 and 9-10, Matsui et al. disclose an endoscope apparatus 101 comprising: an insertion portion 102 having first 141 and second 143 channels arranged therein and terminating at first and second openings, respectively, at a distal portion of the insertion portion; an observation optical system which is arranged to the insertion portion (see Col. 11, Lines 57-59); a first treatment-tool oscillating base which guides, in a first direction, a first treatment-tool 145 guided via the first channel 141 arranged to the insertion portion, the first treatment-tool oscillating base being provided so as to be rotatable in the first opening corresponding to the first channel at a projection side of the first treatment tool; and a second treatment-tool oscillating base which guides, in a second direction, a second treatment-tool 147 guided via the second channel arranged in the insertion portion, the second treatment-tool oscillating base being provided so as to be rotatable in the second opening corresponding to the second channel at a projection side of the second treatment tool; wherein the end of at least one of the first and second treatment-tools guided by the first and second treatment-tool oscillating bases is guided to the outside of a field of view from the inside of an endoscope image based on an optical image obtained by the observation optical system (see Fig. 29 and Col. 14, Lines 10-67). Matsui et al. are silent with respect to a screen size in the guiding direction of the treatment tool guided to the outside of the field of view from the inside is set to have a shorter side, or to be shorter, as compared with

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a screen size in the guiding direction of the treatment tool guided within the inside range of the field of view. Sonnenschein et al. teach of an analogous endoscopic apparatus wherein the field of view for the topical channel may but be non-circular, such as square, rectangular, cylindrical, toroidal section or any other shape. The views may take on any shape and do not need to be of equal size (see Fig. 3c and paragraph 0075). It would have been obvious to one skilled in the art to vary the field of view with respect to the treatment tools of Matsui et al. to provide adequate visualization and alternate view fields of the tools used with the endoscope as taught by Sonnenschein et al.

In regards to claims 5-6, Matsui et al. disclose an endoscope apparatus, wherein the edge of the first treatment-tool is guided to the outside of the field of view from the inside, toward substantially a vertical direction of a screen of the endoscope image, and the edge of the second treatment-tool is guided within the field of view, toward substantially a horizontal direction of the screen of the endoscope image and wherein the outside of the field of view is one in the top direction of the screen of the endoscope image (see Figs 1, 12 and 29 and Col. 14, Lines 10-67).

Response to Arguments

Applicant's arguments with respect to claims 5-7 and 9-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK 

8/23/07


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